

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 22, 2005. At the time of the Office Action, Claims 1-3, 5-10 and 14-17 were pending in this Application. Claims 4 and 11-13 were previously withdrawn due to an election/restriction requirement. Claims 1-3, 5-10, and 14-17 were rejected. Claims 1, 6, 10, and 17 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1-3, 5, 6-10, and 14-17 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 1, 6, 10, and 17 to overcome these rejections and respectfully request full allowance of Claims 1-3, 5, 6-10, and 14-17.

Rejections under 35 U.S.C. § 102

Claims 6-10 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Number JP 04333442 filed by Hiroshi Ogawa et al. ("Ogawa"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the

Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claim 6 recites “a stop mounted before the front edge of the pile pointing in the feeding direction, wherein the front edge of the uppermost sheet is moved against the stop and wherein the *stop can be moved upwards at an impingement angle of at least 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.*” In the present invention,

The sheets pushed from the pile 10 in the feeding direction by the rolling action device 14 (to the right in the figure) reach with their front edge in the feeding direction a stop, which is positioned crosswise in relation to the feeding direction of the sheet. The stop is positioned under a steep angle in relation to the flat plane of the uppermost sheet 12 that is being pushed forward. This impingement angle of the stop in relation to the flat plane and the feeding direction of the uppermost sheet 12 amounts to at least 90 degrees.

(Specification, pg. 9, ln. 23 - pg. 10, ln. 2.) Figures 1 - 4 illustrate that the stop may consist of endlessly running belts 22, which rotate through a lower driven pulley 24 and an upper pulley 26. The planar surface on the belts 22, which is running upwards and is turned towards the pile 10, represents the stop for the sheets of the pile 10. In the shown implementation example, this running upwards planar surface forms with the flat plane and the feeding direction of the fed uppermost sheet 12 at an angle of about 100 degrees. (See Specification, pg. 10, lns. 3 - 11). In the implementation example shown in figures 4 to 9, the stop is built by means of at least one slider 38. The slider 38 is mounted at an impingement angle of at least 90 degrees, or, preferably, about 100 degrees, in relation to the flat plane and the feeding direction of the uppermost sheet 12. (See Specification, pg. 13, lns. 6 - 13).

Alternatively, Ogawa teaches that the paper sheets P are pushed by a roller 19 against the front plate 6. Fur brush rollers 10 lift the front edge of the paper sheets on a bend upper border 6a of the front plate 6 where the front edge of the paper sheet is gripped by rollers 20 and 21. The endless belt 17 is used only to drive the brush rollers 10 but is not connected by the paper sheets P. The endless belt 17 is separated from the stack of paper sheets by the front plate 6 as

shown best in figure 1 of Ogawa. Therefore, Ogawa fails to teach or suggest a “stop can be moved upwards at an impingement angle of at least 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed,” as claimed in claim 6 of the present invention. The invention as claimed in claims 7 - 10 is patentable for similar reasons.

Rejections under 35 U.S.C. §103

Claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ogawa. Applicants respectfully traverse and submit the cited art does not render the claimed embodiment of the invention obvious.

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of U.S. Patent 4,579,329 issued to Walter W. Frost et al. (“Frost”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 14 - 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of Frost. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 1 recites “moving the uppermost sheet with its front edge against *a stop, which is moved under an impingement angle of at least 90 degrees in relation to a flat plane and a direction, in which the uppermost sheet is being fed.*” As noted above, in the present invention,

The sheets pushed from the pile 10 in the feeding direction by the rolling action device 14 (to the right in the figure) reach with their front edge in the feeding direction a stop, which is positioned crosswise in relation to the feeding direction of the sheet. The stop is positioned under a steep angle in relation to the flat plane of the uppermost sheet 12 that is being pushed forward. This impingement angle of the stop in relation to the flat plane and the feeding direction of the uppermost sheet 12 amounts to at least 90 degrees.

(Specification, pg. 9, ln. 23 - pg. 10, ln. 2.) Also, as noted above, Ogawa fails to teach or suggest the invention as claimed. Therefore the invention as claimed in claims 1 - 3 is not obvious in view of Ogawa.

Regarding claim 5, it depends from claim 1 and therefore recites the claim limitation noted above. Frost also does not teach the invention. Frost shows an apparatus for separating a single ply from a stack of plies. The uppermost ply is lifted by an adhesive tape. Then a rotating peeler roller 130 is moved against the underside of the lifted ply in order to remove any clinging plies frictionally. Therefore, the invention as claimed in claim 5 is patentable in view of the combined teachings of Ogawa and Frost.

Regarding claims 14 - 17, these claims depend from claim 6, which recites “a stop mounted before the front edge of the pile pointing in the feeding direction, wherein the front edge of the uppermost sheet is moved against the stop and wherein the *stop can be moved upwards at an impingement angle of at least 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.*” Claims 14 and 15 depend from claim 6. Claim 17 recites “the stop can be moved upwards at an impingement angle of at least 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.” As explained above, neither Ogawa nor Frost disclose a stop as claimed. Therefore the invention as claimed in claims 14 - 17 is patentable in view of the cited prior art.

Association of Customer Number and Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to William Beard at 512.322.2690.

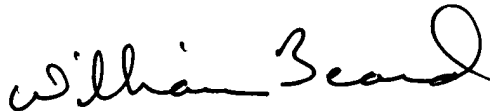
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2690.

Respectfully submitted,
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